

II. Claims 252, 253, 264, 265 and 272, drawn to antagonists of mammalian SNORF72 receptor; and

III. Claims 273-275, drawn to a process of making a composition of matter by synthesizing a compound that binds to or is an antagonist of mammalian SNORF72 receptor.

In support of the restriction requirement, the Examiner alleged that inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as process of identifying and product identified. In the instant case the process for identifying compounds that bind to or are antagonists of mammalian SNORF72 receptor that is invention I can identify the antagonist of invention II, but the method can also identify a different antagonist.

2. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). In the instant case, the antagonist of invention II can be synthesized by the method of invention III, but the antagonist may also be isolated from natural sources, which is a materially different method.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §808.01). In the instant case the different inventions require different method steps and have different goals.

The Examiner concluded that because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The Examiner advised applicants that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

In response to this restriction requirement, applicants elect, with traverse, to prosecute the invention of Examiner's Group I, i.e. Claims 235-251, 254-263, 266-271 and 276-281, drawn to methods of identifying compounds that bind to or are antagonists of mammalian SNORF72 receptor.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants requests that the restriction requirement be withdrawn in view of the fact that the groups of inventions identified by the Examiner are not independent.

Under M.P.E.P. §802.01, "independent" means "there is no disclosed relationship between the ... subjects disclosed, that is, they are unconnected in design, operation, or effect... ." The claims of the groups identified by the Examiner are related in that they are drawn to methods of identifying compounds that bind to or are antagonists of mammalian SNORF72 receptor,

compositions comprising compounds so identified, and processes for making such compositions.

Applicants therefore respectfully assert that two independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any one group identified by the Examiner would necessarily identify art for other groups. Since there is no serious burden on the Examiner to examine the groups in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction set forth in the February 26, 2002 Office Action.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number

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provided below.

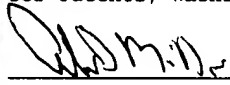
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

 3/26/02

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Date